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| 10/020,739 | 12/18/2001 | Michael D. Miller | 07487 | 9714 |

7590 10/08/2008
LAW OFFICE OF ROBERT O. BLINN
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EXAMINER

PAYER, HWEI SIU CHOU

| | |
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| ART UNIT | PAPER NUMBER |
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3724

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10/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/020,739

Applicant(s)

MILLER, MICHAEL D.

Examiner

HWEI-SIU C. PAYER

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

Detailed Action

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicants' submission filed on August 27, 2008 has been entered.

Drawings Objection

The drawings filed on August 27, 2008 are objected to because:

(1) Reference numeral "41" has been used to designate two different elements as "terminating end" (in Fig.1) and "point" (in Fig.8).

(2) In Fig.9, reference numeral "45" has not been described in the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Objection to the Specification

The disclosure is objected to because of the following informalities:

(1) Reference numeral "41" has been given two designations as "terminating end" (at page 14 of the specification) and "point" (at page 20 of the specification).

Appropriate correction is required.

Claim Objection

Claim 19 is objected to because of the following informalities:

(1) In claim 19, line 21, "may" is indefinite and should be changed to --can--.

(2) In claim 19, line 25, "outer edge of the curved outer tine tines" should read --curved outer edge of the one outer tine--.

(3) In claim 19, line 26, "a user" should read --the user--.

Appropriate correction is required.

Claim Rejection - 35 U.S.C. 103(a)

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cox (U.S. Patent No. 9,687) in view of Centa (U.S. Patent No. Des. 203,072).

Cox shows a universal fork substantially as claimed except it lacks finger platforms.

Centa shows a fork having finger platforms formed on respective sides of the fork handle shaft for receiving finger pressure and thus making the fork handle more ergonomic.

Therefore, it would have been obvious to one skilled in the art at the time this invention was made to modify Cox to provide an alternative handle structure to Cox's fork, such as the one disclosed by Centa, in order to provide amore ergonomic grip for a user.

It is noted, in the above modified Cox, only the bottom side (not both the bottom and top sides) of the handle shaft, at where the finger platforms are, protrudes outwardly. However, to have the top side of Cox's handle shaft also protrude outwardly would have been obvious to one skilled in the art, since a person of ordinary skill would immediately envisage that having the outwardly protruded top side increases the surface the finger platforms and thus aid in more support for a user's finger.

Regarding the newly added limitation "the tines of the fork head also exhibiting upward curvature when viewed from the side", Centa shows such (see Fig.2). Thus, it would have been

obvious to one skilled in the art to have Cox's tines exhibit upward curvature when viewed from the side to facilitate holding and retaining food (when used for scooping) as taught by Centa.

Remarks

Applicant asserts, at page 7 of the amendment, paragraph 0040 of the specification has been amended to add element 45. No such amendment has been found in this amendment. Further, the specification does not have paragraph 0040. Applicant argues, at page 8 of the amendment, Cox issued in 1869 and Centa issued in 1965 and that in the interim period, no one has succeeded in combining the teachings of Cox and Centa and then made further modifications in order to satisfy the long felt need of the public as evidenced by the substantial sale of universal forks made in accordance with the specification and claim. In response, the fact that no one has gotten a patent on this specific combination does not necessarily mean that it is not obvious – it merely means that no one has gotten a patent on this combination. The reason why might be, simply, because the combination is obvious.

The declaration of Michael D. Miller filed on August 27, 2008 has been carefully considered. However, the alleged commercial success does not overcome the rejection for the following reasons:

(1) The declaration must include:

- * A description of what was sold (must include the features of invention as claimed).
- * Description of the relevant market for the product.
- * Sales results. The results should include evidence of market share such as:
 - Total sales for competing products in the market

- Indicate differences between these products and the applicant's
- Pricing of the various products.

* Information on advertising within the relevant market.

(2) The declaration must establish a nexus between the claimed features of the invention and the commercial success. See MPEP 716.03(a).

* The commercial success must be due to the claimed features, and not due to unclaimed features.

The gross sales figures in Mr. Miller's declaration do not show commercial success absent evidence as to market share. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1025, 226 USPQ 881 (Fed. Cir. 1985).

Mr. Miller alleges that this commercial success provides evidence the universal fork is satisfying a long-felt but unsolved need which others have failed to satisfy in the marketplace. Examiner disagrees that this is the case because a successful showing of long-felt need should include evidence of three factors, and Mr. Miller's declaration fails to show such:

(1) The need must have been a persistent one that was recognized by those of ordinary skill in the art. See *In re Gershon*, 372 F.2d 535, 152 USPQ 602 (CCPA 1967).

(2) The long-felt need must not have been satisfied by another before the invention by applicant. See *Newell Companies v. Kenney Mfg. Co.* 864 F.2d 757, 9 USPQ2d 1417 (Fed. Cir. 1988).

(3) The invention must in fact satisfy the long-felt need. See *In re Cavanagh*, 436 F.2d. 491, 168 USPQ 466 (CCPA 1971).

See MPEP 716.04.

In conclusion, the existence of the prior art reference (i.e. the Centa reference) showing a solution to the problem (i.e. providing finger platforms formed on respective sides of a fork handle for receiving finger pressure and thus making the fork handle more ergonomic) is evidence that there is no long-felt need.

The issue here is whether objective evidence of nonobviousness is sufficient to overcome a prima facie obviousness rejection when the prima facie case is especially strong? The answer is no because a strong prima facie obviousness case cannot be defeated by secondary considerations. *Agrizap, Inc. v. Woodstream Corp.* (2008). The asserted claims involve a combination of familiar elements according to known methods to yield “predictable results”. In the present case, Cox shows a prior art fork upon which the claimed invention is an improvement. Centa shows a fork that is improved in the same way as the claimed invention (i.e. by providing finger platforms formed on respective sides of a fork handle) to achieve the predictable result of receiving finger pressure and thus making the fork handle more ergonomic. Therefore, one of ordinary skill in the art could have applied the known “improvement” technique (i.e. finger platforms) in the same way to Cox’s fork handle shaft and the result would have been predictable.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 571-272-4511. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for official communications and 571-273-4511 for proposed amendments.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H Payer
October 3, 2008

/Hwei-Siu C. Payer/
Primary Examiner, Art Unit 3724